

Remarks

Claims 1-40, 44 and 45 are pending in this application.

Claims 1 and 44 are independent.

Claims 12-34 stand withdrawn.

Claims 1-11, 35-40, 44 and 45 are under consideration.

Claim 45 is objected to as being dependent upon a rejected base claim, but is otherwise allowable.

For clarification, applicants take this opportunity to discuss the relationship of the U.S. Patents and applications owned by Ciba Specialty Chemicals and aimed at pulp or paper stabilization.

Family 1 : Inhibition of Pulp and Paper Yellowing Using Nitroxides, Hydroxylamines and Other Coadditives

Attorney Docket No. PW/3-21393/21414/P2/CGC 1946/CGC 1948

This family is aimed at hindered amine compounds towards the stabilization of pulp or paper.

App. No. 09/119,567, filed July 20, 1998, now U.S. Pat. No. 6,254,724

Contains claims to pulp or paper compositions comprising hindered hydroxylamine compounds or their salts, and to a process of stabilizing pulp or paper with said compounds.

App. No. 09/573,401, filed May 18, 2000, now U.S. Pat. No. 6,500,303

A divisional of app. No. 09/119,567, contains claims to certain hindered nitroxyl compounds and hindered hydroxylamine salts.

App. No. 09/974,382, filed Oct. 10, 2001, now U.S. Pat. No. 6,447,644

A divisional of app. No. 09/573,401, contains claims to paper compositions comprising hindered nitroxyl compounds and to a process of stabilizing paper with said compounds.

Family 2 : Inhibition of Pulp and Paper Yellowing Using Hydroxylamines and Other Coadditives

Attorney Docket No. PW/3-21855/P2/CGC 2002

This family is aimed at dialkylhydroxylamines towards the stabilization of pulp or paper.

App. No. 09/234,253, filed Jan. 20, 1999

The present application, contains claims toward pulp or paper compositions comprising dialkyl- or substituted dialkylhydroxylamine compounds or their corresponding salts.

App. No. 10/140,531, filed May 7, 2002

A divisional of 09/234,253. Contains claims towards a process of stabilizing pulp or paper with dialkyl- or substituted dialkylhydroxylamine compounds or their corresponding salts.

Family 3 : Inhibition of Pulp and Paper Yellowing Using Hydroxylamines and Other Coadditives

Attorney Docket No. PW/3-21961/P2/CGC 2012

This family is aimed at dialkylhydroxylamines towards the stabilization of chemical pulp or paper.

App. No. 09/481,665, filed Jan. 12, 2000, now U.S. Pat. No. 6,599,326

This issued patent contains claims to chemical pulp or paper comprising dialkylhydroxylamines or substituted dialkylhydroxylamine compounds or their corresponding salts, and to a process of stabilizing chemical pulp or paper with said compounds.

Family 4 : Inhibition of Pulp and Paper Yellowing Using Nitroxides, Hydroxylamines and Other Coadditives

Attorney Docket No. PW/3- 21962/P2/CGC 2013

This family is aimed at hindered amine compounds towards the stabilization of chemical pulp or paper.

App. No. 09/483,017, filed Jan. 13, 2000

Contains claims towards chemical pulp or paper compositions comprising hindered nitroxyl compounds, hindered hydroxylamine compounds, and hindered hydroxylamine salts, and to a process of stabilizing chemical pulp or paper with said compounds.

Family 5 : Chlorohydrin and Cationic Hindered Amine Compounds Having High Affinity for Pulp or Paper

Attorney Docket No. PW/3-22082/P1/CGC 2041

This family is aimed at chlorohydrin or cationic compounds having nitroxide or hydroxylamine moieties for the stabilization of pulp or paper.

09/658,924, filed Sep. 11, 2000

Contains claims to chlorohydrin or cationic hindered amine compounds, and to a process of stabilizing pulp or paper with said compounds.

Family 6 : Stabilization of Wood Substrates

Attorney Docket No. CO/21-21511/A

This family is aimed at the stabilization of wood with hindered amine compounds.

App. No. 09/267,472, filed March 11, 1999, now U.S. Pat. No. 6,187,387

Contains claims to a method of protecting wood with certain hindered nitroxyl compounds, hindered hydroxylamine compounds, or hydroxylamine salt compounds.

Obviousness-type double patenting rejections are warranted for the present claims over claims of the following commonly assigned applications :

- U.S. Pat. No. 6,254,724; there is a small area of overlap of the present claims with those of this issued U.S. Patent, for example when Z₁ and Z₂ of claim 1 of U.S. '724 are each methyl, and when the compound of claim 6 is of formula (S).

-App. No. 09/481,665 (U.S. Pat. No. 6,599,326) ; the present composition claims toward pulp or paper are generic to the claims of this issued patent aimed at chemical pulp or paper.

- App. No. 09/483,017; the present claims have some slight overlap in the same way that U.S. Pat. No. 6,254,724 does.

There is no overlap of the present claims with those of co-pending application No. 09/658,924. The hindered amine compounds of this reference are all cyclic. The hydroxylamines of the present claims are all acyclic.

There is no overlap of the present claims with those of commonly assigned U.S. Pat. No. 6,187,387. The compounds of the claims of this patent are all cyclic. The hydroxylamines of the present claims are all acyclic.

There is no overlap of the present claims with those of U.S. Pat. No. 6,500,303. The claims of this patent are to certain compounds. The present claims are to pulp or paper compositions. Further, the compounds of the claims of U.S. '303 are all cyclic. The compounds of the present claims are all acyclic.

There is no overlap of the present claims with those of U.S. Pat. No. 6,447,644. The compounds of the claims of this patent are nitroxyl compounds (E therein is oxyl, or O•). The compounds of the present claims are hydroxylamines.

Applicants submit that claims that issue from the present application will not improperly extent the right to exclude already granted in U.S. Pat. Nos. 6,500,303 and 6,447,644.

Applicants submit that terminal disclaimers for the present application are proper over U.S. Pat. No. 6,254,724 and app. Nos. 09/481,665 and 09/483,017. Applicants also submit that no other terminal disclaimers are required for any other of the above mentioned commonly assigned applications or U.S. Patents.

Terminal disclaimers over each of U.S. Pat. No. 6,254,724 and app. Nos. 09/481,665 and 09/483,017 were submitted with the response mailed May 23, 2003. The 3 terminal disclaimers were also again faxed to Brenda Murphy at the PTO on June 11, 2003.

True copies of these 3 terminal disclaimers are attached herewith.

Applicants also submit herewith a copy of the return receipt postcard that accompanied the response mailed May 23, 2003, date stamped in the PTO on May 27, 2003.

Applicants also submit a copy of the fax confirmation report, indicating that all three terminal disclaimers were successfully faxed to the PTO on June 11, 2003.

Applicants also submit a copy of Ciba Specialty Chemicals monthly statement with the PTO, indicating that the PTO charged for the 3 terminal disclaimers.

Applicants note that the three terminal disclaimers have identical titles, and therefore some confusion may have arisen. Attached to the enclosed copies of the terminal disclaimers are post-it notes to indicate which patent or application the disclaimer is over. Applicants do note that only one terminal disclaimer is present in the PAIR system.

Regarding the 35 USC 103(a) rejections of the present claims over Seltzer '511 in view of Rogers '222, the Examiner is kindly requested to refer to the arguments of the "Supplemental Appeal Brief" filed Dec. 12, 2002.

The Examiner is kindly requested to reconsider and to withdraw all present rejections under obviousness-type double patenting and 35 USC 103(a).

Applicants submit that the present claims are in condition for allowance and respectfully request that they be found allowable.

The Examiner is also kindly requested to consider rejoining dependent claims 12-34. Claims 12-34 are also composition claims and contain all the limitations of present claim 1.

Respectfully submitted,



Tyler A. Stevenson
Agent for Applicants
Reg. No. 46,388

Ciba Specialty Chemicals Corp.
540 White Plains Road
P.O. Box 2005
Tarrytown, NY 10591-9005
Tel. (914)785-2783
Fax (914)785-7102

Attachments: Terminal disclaimer over app. No. 09/481,665 (true copy)
Terminal disclaimer over app. No. 09/483,017 (true copy)
Terminal disclaimer over U.S. Pat. No. 6,254,724 (true copy)
Return receipt postcard date stamped May 27, 2003
Copy of PTO account monthly statement
Copy of fax transmission report